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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

080398.P506

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on March 3, 2006

Signature

Typed or printed name Carla Anysia Nascimento

Application Number

09/904,449

Filed

July 11, 2001

First Named Inventor

Hawley K. Rising, III

Art Unit

2162

Examiner

Jean M. Corrielus

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 37,850☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

SignatureSheryl Sue Holloway

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408-720-8300

Telephone number

MARCH 3, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☒*Total of 1 forms are submitted.

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City Docket No. 080398.P506

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Examiner:	Corrielus, Jean M.
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Hawley K. Rising, III) Art Unit:	2162
)	
Serial No. 09/904,449) Confirmation No.:	9713
)	
Filed: July 11, 2001)	
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For: FORMAL VERIFICATION OF)	
SEMANTIC DS)	
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MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action mailed November 3, 2005, Applicant respectfully requests review of the Examiner's rejections of claims 1-12.

Rejections To Be Reviewed

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-22 stand rejected under § 112, first paragraph, as not enabled by the Specification.

Summary of Claimed Subject Matter

Applicant's invention as claimed creates an abstract of a semantic description of a piece of content. The abstract can subsequently be used to create (instantiate) a semantic description of another piece of content. The term "semantic description" is defined at paragraph 17 of the Specification. At paragraph 63, the Specification describes abstracting a semantic description into a template by severing the references of the

semantic description to a specific piece of content. Paragraphs 63 and 64 describe the use of the abstraction of the semantic description, i.e., the template, to instantiate other descriptions. Paragraph 64 further describes storing the abstract as a structure, such as a dictionary or classification scheme. Paragraphs 79-81 describe a particular embodiment of the invention with reference to Figure 2.

Summary of Prosecution History

In a final Office Action mailed November 3, 2005, the Examiner rejected claims 1-22 under 35 U.S.C. § 112, first paragraph because the Specification did not enable the claimed production of an abstract of a semantic description and a structure representing an abstract of the semantic description. In addition, the Examiner objected to the drawings as not illustrating the production of an abstract of a semantic description or the structure representing an abstract of the semantic description. The Examiner also stated that claims 1-10 and 12-17 would be allowable if the § 112 rejection was overcome.

In a Response after Final on December 27, 2005, Applicant cancelled claims 11 and 18-22, leaving only claims 1-10 and 12-17 pending. Applicant specifically pointed out blocks in Figure 2 that illustrated the claimed elements. Applicant also pointed out specific paragraphs of the Specification that described the blocks of Figure 2, and argued that Figure 2 and the corresponding description enabled the claims.

In an Advisory Action mailed on January 18, 2006, the Examiner maintained the § 112 rejection, stating that the cited sections and figures were not enabling because the exact phrase "abstract of the semantic" [sic] did not appear in the Specification. The Advisory Action did not maintain the objection to the drawings. Because the Amendment after Final was not entered, claims 1-22 are pending.

Argument

In the Response after Final of December 27, 2005, Applicant directed the Examiner's attention to blocks 214, 216 and 218 of Figure 2, and quoted paragraphs 79-81 of Specification that describe those blocks. For purposes of brevity, paragraphs 79-81 are summarized instead of being reproduced in their entirety. As described in the Specification, blocks 214-216 represent operations that create a semantic description of

specific content selected by a user. Block 218 represents operations that save an abstract of the description for later use and its storage as a structure.

Although the exact phrase "abstract of the semantic description" does not appear within the Specification, Applicant is unaware of any case law that holds a claim term must appear in its exact form in a Specification to have enablement of a claim. Applicant respectfully submits that the rejection must be based on the description of the Specification taken as a whole.

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. [MPEP 2164.04]

Applicant respectfully submits that Figure 2, its corresponding description, and the paragraphs cited under the Summary herein, when read in context of the Specification as a whole, describe how to create an abstract of a semantic description.

Furthermore, Applicant notes that the lack of enablement reason given in the Advisory Action is different that the lack of enablement reason given in the Final Office Action of November 3, 2005. In the final Office Action, the Examiner stated that the Specification did not describe a specific linking mechanism that creates the abstract. Applicant respectfully submits that paragraph 79 describes an embodiment in which a graph serves as the linking mechanism. Because the use of graphs is well-known in the art of audiovisual description, Applicant respectfully submits that one of skill could practice the claimed invention without undue experimentation after reading the Specification.

Conclusion

Because the drawings and description in the Specification do enable Applicant's invention as claimed, the Examiner is in error in rejecting the claims under 35 U.S.C. § 112, first paragraph. Because the Examiner did not maintain the objection to the drawings in the Advisory Action and the rejection under § 112 has been overcome, claims 1-10 and 12-17 are allowable. Therefore, Applicant respectfully requests the Pre-Appeal Conference direct the Examiner to enter Applicant's Amendment after Final and to enter an allowance for claims 1-10 and 12-17.

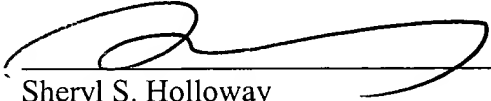
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: March 3, 2006



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